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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/723,018 | 11/26/2003 | Hugh Harnsberger | 12382.0015.P | 1781 |
| 7590 10/04/2007 | | | | |
| Brent T. Winder | | | | |
| Jones Waldo Holbrook & McDonough | | | | |
| Suite 1500 | | | | |
| 170 South Main Street | | | | |
| Salt Lake City, UT 84101 | | | | |
| | | EXAMINER | | |
| | | FILIPCZYK, MARCIN R | | |
| | | ART UNIT | | PAPER NUMBER |
| | | 2163 | | |
| | | MAIL DATE | | DELIVERY MODE |
| | | 10/04/2007 | | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,018

Applicant(s) *mn*

HARNSBERGER ET AL.

Examiner

Marc R. Filipczyk

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2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

This Action is responsive to Applicant's response filed on March 22, 2007 wherein claims 1-15 are examination pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 1, the limitation of "generating the medical reference book on the desired topic" was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, instead is only briefly mentioned in the preamble.

As to claims 2-10, they depend from claim 1 and are rejected on the same merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 9, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the term, "medical reference information" is indefinite. It is not clear what the metes and bounds of medical reference information are, whether they include all or part of the data entered and created by tools.

As to claims 2-10, they comprise similar subject matter as claim 1 and are therefore rejected on the same merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefanescu et al (U.S. Publication No. 2003/0013951).

Regarding claims 1, 6 and 9, Stefanescu discloses a method and system for creating a medical reference book on a desired topic, comprising the steps of: (abstract)

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entering medical reference information in an electronic authoring tool (figures 4-7), the electronic authoring tool including: (fig. 4, page 5, par. 50, lines 1-16)

a master outline authoring tool (figures 4-7), whereby an author is able to create a linkage between a diagnosis, an anatomical region, and a pathology; (par. 53, lines 1-6 and par. 56, lines 5-8)

a case authoring tool (figures 4-7), whereby the author is able to enter and edit images and text relating to a particular case; (par. 52, lines 6-12, par. 54, lines 13-23 and par. 56).

a diagnostic authoring tool (figures 4-7), whereby the author is able to create a comprehensive description of the diagnosis; (par. 55, lines 3-5)

transferring the medical reference information into a content database; (figs. 8 and 10, page 9, par. 83 and 84)

*(Note 1: limitations **above** teach building and using a medical database system)*

*(Note 2: limitations **below** teach searching and retrieving the desired material from the medical database system)*

selecting a desired topic about which the electronic clinical reference material is to be created; (pages 9, par. 89)

navigating the content database for medical reference information pertaining to the desired topic; (page 10, par. 92 and 93) and

generating the medical reference book on a desired topic (page 10, par. 92 and 93).

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Regarding claim 2, Stefanescu discloses reviewing the medical reference information prior to transferring it to the content database (fig. 8, item 824 and par. 92).

Regarding claims 3 and 4, Stefanescu discloses reference book is a printed and or electronic book (par. 93).

(Note: all electronic documents may be in printed)

Regarding claim 5, Stefanescu discloses a GUI (figs. 4-7 and par. 70).

Regarding claim 7, Stefanescu discloses providing imaging protocols (page 11, par. 99).

Regarding claim 8, Stefanescu discloses a continuing education system comprising performance and credits (figs 4 and 16, item 1634, also see *internet*).

Regarding claim 10, Stefanescu discloses database is searchable online (fig. 1 and col. 25).

Regarding claims 11-15, they disclose limitations already addressed and rejected in the rejection above, in addition see fig. 2, items 200-206 of Stefanescu.

Response to Arguments

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Applicant's arguments filed on March 22, 2007 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on page 7 that indefinite rejections have been overcome by the current amendments.

Examiner disagrees. Applicant has clarified that medical data and medical reference information are synonymous, however the questions submitted with respect to the scope of medical data has not been addressed. Further, Examiner notes that the aspect of creating a book is not taught or disclosed by the Applicant's disclosure and is therefore rejected as new matter.

Applicant argues on pages 8 and 9 that the new amended feature of "creating medical reference book" is not taught by Stefanescu.

Examiner disagrees. The limitation Applicant relies on "creating medical reference book" is not taught by the disclosure and is therefore rejected as new matter and not enabling. Stefanescu further teaches generating medical files for clients, see rejection above.

Applicant argues on page 9 that the prior art does not teach all the tools.

Examiner disagrees. The claimed tools include an interface creating links between a diagnosis, anatomical region and pathology, entering data, diagnosing the data, all of which is taught by Stefanescu in paragraphs 53, 55 and 56. Note, Stefanescu's matching linkage is achieved by a matching button for matching reference text to images and clinical data used by the system, see paragraph 56.

Applicant argues that the prior art does not teach the novelty included in the specification including XML tagged data and radiology imaging equipment. Further, claim 11 is argued in general.

Examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., XML tagged data, radiology imaging equipment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner further notes that Stefanescu is directed to solve the same problems as the pending Application and discloses all the claimed limitations.

With regard to claim 11, Examiner notes that the claim is a system claim and should therefore comprise structure, instead processes and a general database are claimed that are taught by Stefanescu.

With respect to all the pending claims 1-15, Examiner respectfully traverses Applicants assertions based on the discussion and rejection cited above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents demonstrate the state of art with respect to medical systems.

U.S. Patent No. 6,263,330 of Bessette

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U.S. Patent No. 6,757,898 of Ilsen et al.

U.S. Patent No. 6,850,944 of MacCall et al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

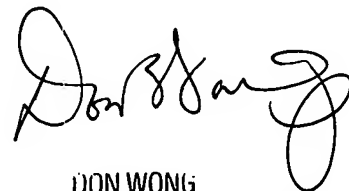
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

September 21, 2007



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100